

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
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Steven R. Ligon et al.)	Art Unit: 4114
)	
Serial No. 10/690,657)	Confirmation No.: 5863
)	
Filed: October 23, 2003)	Examiner: Mansfield, Thomas
)	
For: System and Method for Determining)	
Performance Level Capabilities in View of)	
Predetermined Model Criteria)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW PURSUANT TO USPTO OG NOTICE
OF JULY 12, 2005**

Mail Stop AFTER-FINAL (AF)
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

November 4, 2008

Sir:

In connection with a Notice of Appeal and the appropriate Notice fee filed herewith, the Applicants are submitting this Pre-Appeal Brief Request for Review in connection with the above-identified application which is currently under a Final Rejection mailed on July 24, 2008. The Applicants believe that there are clear errors in the Examiner's rejections and that there are several Examiner omissions of one or more essential elements that are claimed and which are needed to establish a prima facie rejection.

Simply, the primary reference relied upon by the Examiner does not teach or suggest several of the elements enumerated in independent Claims 1, 9, and 15 of the application. The Examiner has directed the Applicants to several different passages of PCT Publication No. 2001/25970 published in the name of Skoyles-Greenberg ("Skoyles-Greenberg") as allegedly teaching specific elements of the Applicants' claimed invention. The Applicants have thoroughly reviewed the passages relied upon by the Examiner. After this exhaustive review, the

Applicants do not believe the Skoyles-Greenberg or any of the prior art references alone or in combination provide the teachings asserted by the Examiner.

The Applicants respectfully submit that Skoyles-Greenberg is a document which discusses the use of computers for some of the steps in its methods described therein, however, several steps and several methods described by the Skoyles-Greenberg reference are performed by humans and do not suggest any processing by a computer. The Applicants believe that the Examiner is making several assumptions when he relies upon Skoyles-Greenberg to address several elements of the Applicants' three independent claims. The Examiner is asserting that since Skoyles-Greenberg suggests the use of computers for some of its steps, then one of ordinary skill in the art would assume that all steps described by Skoyles-Greenberg can then be performed by a computer. However, the Applicants believe that such an assumption is incorrect and that Skoyles-Greenberg fails to provide essential and requisite detail to enable one of ordinary skill in the art to perform every step relied upon by the Examiner with a computer. At a minimum, the Examiner needs to provide at least two more foundations to establish his case: (1) at least one more reference to explain how several of the steps performed by humans in the Skoyles-Greenberg reference would be programmed for a computer AND (2) detailed rationale of why one of ordinary skill in the art would modify the Skoyles-Greenberg reference in such a manner.

To assist the Panel with its review, the Applicants direct the Panel to several different passages of the Rule 116 Response filed by the Applicants on October 1, 2008 which clearly establish that many of the steps relied upon by the Examiner in the Skoyles-Greenberg reference are performed only by humans and not a computer:

References to Applicants After Final Rule 116 Response ("Response") of October 1, 2008 but identify specific elements of the independent claims which are not taught by Skoyles-Greenberg.

(1) One of ordinary skill in the art recognizes that page 2, line 13 through page 3, line 15 of Skoyles-Greenberg does not provide any teaching of the claimed element of "providing individual requirements of at least one maturity model on a display." See Response, page 8, last paragraph through page 9, last paragraph.

(2) One of ordinary skill in the art recognizes that page 3, lines 1-15 of Skoyles-Greenberg does not provide any teaching of the claimed element of "providing individual

requirements of at least one maturity model on a display.” The referenced passage of Skoyles-Greenberg explains some details about steps in a process, but these paragraphs do not explain that steps are performed by a computer. See Response, page 10, first and second paragraphs.

(3) One of ordinary skill in the art recognizes that page 3, lines 1-15 of Skoyles-Greenberg teaches a computer system for allocating time and computing costs for “building an OMM function in an information technology system.” However, this technology for “building” an OMM assessment function is not the same as “providing the individual requirements of at least one maturity model on a display,” as recited in independent Claim 1. See Response, page 10, last paragraph through page 11, first paragraph.

(4) One of ordinary skill in the art recognizes that page 9, lines 3-26 of Skoyles-Greenberg may teach a computer with an interface, however, the passage does not provide any teaching of “generalized work products” or “storing the generalized work products in a first table.” See Response, page 11, second paragraph through page 12, first paragraph.

(5) One of ordinary skill in the art recognizes that page 5, line 23 through page 7, line 24 of the Skoyles-Greenberg references software, however, the passage is stating that the Skoyles-Greenberg technology provides a “gap analysis” which is similar to existing software methods. This passage does not make it clear to one of ordinary skill in the art if the “gap analysis” of the Skoyles-Greenberg technology is actually performed by a computer processor. See Response, page 12, second paragraph through page 14, first paragraph.

(6) One of ordinary skill in the art recognizes that page 10, line 17 through page 11, line 27 of Skoyles-Greenberg does not provide any teaching of, “... related the individual requirements of at least one maturity model stored in a second table to the generalized work products stored in the first table.” One of ordinary skill in the art recognizes that this passage from Skoyles-Greenberg is explaining the work which will be performed by human operators to complete Tasks 1521 and 1523 as illustrated in Figure 2 of Skoyles-Greenberg. See Applicants’ Response, page 15, first paragraph through page 17, first paragraph.

(7) One of ordinary skill in the art recognizes that the detailed description of Skoyles-Greenberg explains how the four steps illustrated in Figure 1 are combined by human team members to provide an operation maturity model (OMM) assessment. The Skoyles-Greenberg reference explains how it may be helpful to consider the steps illustrated in Figure 1 as being grouped into three stages by the human team members. Throughout Skoyles-Greenberg, it is

evident that the process being described is completed by humans without any interaction with a computer. See Response, page 19, second paragraph through page 20.

(8) The Applicants submit that the secondary references of U.S. Patent Application Publication No. 2004/0010709 published in the name of Baudoin (“Baudoin”) and U.S. Patent No. 7,136,792 issued in the name of Balz et al. (“Balz”) fail and do not make up for the numerous deficiencies of Skoyles-Greenberg identified above. The Applicants further submit U.S. Patent No. 5,765,138 issued in the name of Aycock (“Aycock”) also does not make up for the numerous deficiencies of Skoyles-Greenberg. The Applicants submit that none of the references suggests or teach providing individual requirements of at least one maturity model on a display, receiving generalized work products through a user interface and storing the generalized work products in a first table, and with a computer processor, relating the individual requirements of at least one maturity model stored in a second table to the generalized work products stored in the first table as recited in the amended independent claims. See Response, page 27, second full paragraph through page 28, first full paragraph.

CONCLUSION

The Applicants believe that there are clear errors in the Examiner’s Final Rejection of July 24, 2008. Additionally, the Applicants believe that the Examiner’s Final Rejection of July 24, 2008 also contains numerous omissions of one or more essential elements needed to establish a prima facie case of rejection. In view of the concise arguments presented above, the Applicants respectfully request at least that the prosecution on the merits is reopened and a proposed amendment be provided from the Panel, or alternatively, the Applicants request a finding that the application is allowed on the existing claims and that the prosecution of these claims remains closed.

Should the Examiner or the Panel determine that any further action is necessary to place this application into better form so that it is in condition for allowance, they are encouraged to telephone the undersigned representative at the number listed below. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to deposit account no. 50-4402.

Respectfully submitted,

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